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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,893	07/21/2003	Henry M. Donzis	122085.002.005	7649
7590 07/09/2008				
ROBERT C. CURFISS JACKSON WALKER L.L.P. SUITE 2100 112 EAST PECAN STREET SAN ANTONIO, TX 78205				
EXAMINER				
HALDM, SAHERA				
ART UNIT		PAPER NUMBER		
2157				
MAIL DATE		DELIVERY MODE		
07/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/623,893

Applicant(s)

DONZIS ET AL.

Examiner

SAHERA HALIM

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to Amendment filed April 2, 2008.
2. Claims 1-52 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner what the applicant is claiming by the limitation of "examining, by the redirecting device, the accessed user upstream traffic to determine if it is possible to send a redirection". The claim fails to specify a redirection for what. It is unclear whether a redirection being determined for a message or user request or user upstream traffic. Appropriate correction is required.
5. Claim 1 recites the limitation "the user" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 1 recites the limitation "if it is possible" in line 11 of the claim. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 1 recites the limitation "the specially-composed bulletin message" in line 15 of the claim. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 1 recites the limitation "the subscriber" in line 16 of the claim. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 1 recites the limitation "the destination site" in line 16 of the claim. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is also unclear whether "users of an Internet service provider" is the same as "the user that request upstream traffic".

11. The term "normally" in claim 1 is a relative term which renders the claim indefinite. The term "normally" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what is normal and what is abnormal by the claim.

The examiner noticed multiple negative or exclusionary limitations in claim 1 and directs the applicant to the following recitations in the MPEP. Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.

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See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234,1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.**2173.05(j)**.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-44, 46-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Bakshi et al. US Patent No. 6,772,200. Bakshi teaches the invention as claimed including sending messages to users (see abstract).

As per claim 1, Bakshi teaches a method for communicating real-time to users of an Internet service provider, comprising the steps of:

accessing by a redirecting device [Figure 1, network device, column 2, lines 39-67; Figure 4, local proxy, column 6, lines 63-67; column 7, lines 1-10) only user upstream traffic from a destination site requested by the user (advertising module 9 monitors communications link to detect the existence of an open connection; column 3, lines 1-6; local proxy intercepts all request issued by browser; column 7, lines 10-12);

b. Identifying the user by using data available from the user and provider infrastructure to provide a fixed identifier based on the accessed user upstream traffic (user profile; column 3, lines 1-23; the banner request signal contains information needed to tell an information server what type of banner is requested by the terminal; column 15, lines 16-41);

c. Providing, by the redirecting device, the fixed identifier to a consolidating and management device [Figure 1, advertising service provider 5; Figure 4, Network proxy 4];

if a message for the user is desired, examining, by the redirecting device, the accessed user upstream traffic to determine if it is possible to send a redirection, wherein the examining occurs without modifying user upstream traffic (network proxy services a large number of client devices; column 7, lines 15-20; the computer site,

information server, or other device receive the initial request banner signal from the terminal 36, column 10, lines 58-67; column 11, lines 1-8; column 15, lines 41-67; column 16, lines 1-10); and

d. Selectively redirecting the message to the user for display on the message vehicle [display on the GUI 11; using the redirect signal to specify a banner; column 17, lines 34-67; column 18, lines 1-30], and

if the specially-composed bulletin message for the user is not desired, allowing, by the redirecting device, a direct connection from the subscriber to the destination site to proceed normally, and sending, only by the destination site, downstream web traffic to the user without forwarding the downstream web traffic through or by the redirecting device (col. 17, lines 34-67 and col. 18, line 1-30).

As per claim 2, Bakshi teaches the method of claim 1, wherein the message vehicle is a pop-up window on the user PC's browser (column 7, lines 48-59).

As per claim 3, Bakshi teaches the method of claim 1, further including the step of transmitting to the user a vehicle for displaying and communicating a message from the consolidating and management device to the user (sending the user a DAM; column 2, lines 52-65).

As per claim 4, Bakshi teaches the method of claim 1, wherein the insertion step includes web cache control protocol (column 5, lines 1-10).

As per claim 5, Bakshi teaches the method of claim 1, wherein the insertion step includes switching mechanisms in an existing ISP router or switch (column 2, lines 40-52).

As per claim 6, Bakshi teaches the method of claim 1, wherein the message vehicle is a prompt provided on the user PC (column 7, lines 48-59).

As per claim 7, Bakshi teaches the method of claim 1, wherein the fixed identifier is a unique identifier of the user, such as a modem address (column 3, lines 1-33)

As per claim 8, Bakshi teaches the method of claim 1, wherein the message is transmitted in response to an event determined by the redirecting device (column 3, lines 1-33).

As per claim 9, Bakshi teaches the method of claim 1, wherein the user is identified to belong to a defined group of users and wherein the message is selectively sent to a pre-selected user group (column 2, lines 40-52).

As per claim 10, Bakshi teaches the method of claim 1, wherein the redirecting device is adapted for working through Web browsers irrespective of the World Wide Web destination sought by the user identifier (column 4, lines 1-21).

As per claim 11, Bakshi teaches the method of claim 10, wherein the redirecting device returns the user to the original World Wide Web destination after the message has been transmitted (column 3, lines 1-33).

As per claim 12, Bakshi teaches the method of claim 1, wherein the redirecting device is adapted for working with multiple types of content (column 4, lines 1-21)

As per claim 13, Bakshi teaches the method of claim 1, wherein the redirecting device comprises a hardware device that can be simply connected at various points, in plurality, in a provider infrastructure (column 2, lines 40-52).

As per claim 14, Bakshi teaches the method of claims 13, further including a plurality of redirecting devices (column 2, lines 40-52).

As per claim 15, Bakshi teaches the method of claim 13, further including the step of providing optional fail-safe operation of each device such that failure does not disrupt other normal browsing and Internet activity of the user but results only in an

interruption of bulletin delivery (column 3, lines 35-67).

As per claim 16, Bakshi teaches the method of claim 1, wherein the redirecting device comprises a software system installed on a computer system that is connected at various points, singly or in plurality, in a provider infrastructure (column 2, lines 40-52).

As per claim 17, Bakshi teaches the method of claims 16, further including a plurality of redirecting devices (column 2, lines 40-52).

As per claim 18, Bakshi teaches the method of claim 16, further including the step of providing optional fail-safe operation of each device such that failure does not disrupt other normal browsing and Internet activity of the user but results only in an interruption of bulletin delivery (column 3, lines 35-67).

As per claim 19, Bakshi teaches the method of claim 1, further including the step of defining a specific policy for controlling the selective transmission of messages to the user (column 3, lines 1-33).

As per claim 20, Bakshi teaches the method of claim 19, further including the step of defining a policy Web or other page information (column 3, lines 1-33).

As per claim 21, Bakshi teaches the method of claim 19, further including the step of defining a policy that includes timing and frequency of delivery (column 3, lines 1-33).

As per claim 22, Bakshi teaches the method of claim 19, further including the step of defining a policy for activating the redirecting device to deliver a message in response to other user activity (column 3, lines 35-67).

As per claim 23, Bakshi teaches the method of claim 22, wherein the activity comprises a defined destination (column 3, lines 35-67).

As per claim 24, Bakshi teaches the method of claim 22, wherein the activity comprises the amount of activity by the user (column 3, lines 35-67).

As per claim 25, Bakshi teaches the method of claim 22, wherein the activity comprises a request carrying the signature of virus contamination (column 4, lines 48-52).

As per claim 26, Bakshi teaches the method of claim 1, further including the step of generating a plurality of independently designated policies to be delivered correctly to the user even if some policy events invoke in simultaneity (column 3, lines 35-67).

As per claim 27, Bakshi teaches the method of claim 26, wherein the redirecting device includes the ability to acquire the knowledge of the policies and the identifier when a Web or other request is detected with only an identifying IP address (column 3, lines 1-33).

As per claim 28, Bakshi teaches the method of claim 27, wherein the redirecting device is adapted for minimizing the overhead of acquiring user parameters through caching of that information for a determined portion of the time during which the protocol announces it as valid (column 3, lines 1-33).

As per claim 29, Bakshi teaches the method of claim 1, wherein the redirecting device is adapted for use in connection with a consolidating system management device for permitting a group of system devices to be viewed by the provider as a single system (column 1, lines 40-52).

As per claim 30, Bakshi teaches the method of claim 1, wherein the identifier step uses the enforced delivery of a Web page to be used in the distribution and subscription of new users without prior knowledge of the serial numbers associated with the new user's interface equipment and without requiring the user to utilize special software (column 6, lines 5-19).

As per claim 31, Bakshi teaches the method of claim 30, further comprising the step of using the enforced delivery of a Web page to reduce the volume of telephone support requests by the enforced pre-announcement of known, future system outages due to scheduled maintenance (column 3, lines 1-33).

As per claim 32, Bakshi teaches the method of claim 30, further comprising the step of using the identifier for detection of "signature" forms of Internet packets that indicate the presence of undesirable content (column 4, lines 48-52; column 7, lines 50-67; column 8, lines 1-16).

As per claim 33, Bakshi teaches the method of claim 32, wherein the undesirable content is a virus (column 4, lines 48-52; column 7, lines 50-67; column 8, lines 1-16).

As per claim 34, Bakshi teaches the method of claim 32, further including the step of transmitting a message identifying the undesirable content to the provider (column 4, lines 48-52; column 7, lines 50-67; column 8, lines 1-16).

As per claim 35, Bakshi teaches the method of claim 32, further including the step of transmitting a message identifying the undesirable content to the user (column 4, lines 48-52; column 7, lines 50-67; column 8, lines 1-16).

As per claim 36, Bakshi teaches the method of claim 34, further including the step of logging the undesirable content identifying message (column 4, lines 48-52; column 7, lines 50-67; column 8, lines 1-16).

As per claim 37, Bakshi teaches the method of claim 31, wherein the transmitting step includes enforcing the delivery of other user-beneficial information that is currently displayed on the manually accessed provider information Web site (column 3, lines 1-33; column 7, lines 1-50).

As per claim 38, Bakshi teaches the method of claim 19, further including the step of logging successful implementation of policies to each user (column 3, lines 1-33; column 7, lines 1-50).

As per claim 39, Bakshi teaches the method of claim 19, further including the step of logging interactive responses that have been requested within the policy (column 3, lines 1-33; column 7, lines 1-50).

As per claim 40, Bakshi teaches the method of claim 19, further including the steps of detecting and logging the number of simultaneously requested Web connections (column 3, lines 1-33; column 7, lines 1-50).

As per claim 41, Bakshi teaches the method of claim 40, further including the step of flagging users that are utilizing more than one simultaneous device per subscription (column 3, lines 1-33; column 7, lines 1-50).

As per claim 42, Bakshi teaches the method of claim 19, further including the step of transmitting explanations to be issued, in an enforced manner, to subscribers, after a service interruption, in such a manner as to alleviate customer dissatisfaction by illuminating and explaining the problem and the efforts that are to be taken in the future to eliminate such problems (column 7, lines 1-20).

As per claim 43, Bakshi teaches the method of claim 1, wherein the inserting step includes inserting a redirecting device in the path of web traffic from the user through an ISP (column 7, lines 1-20).

As per claim 44, Bakshi teaches the method of claim 1, wherein the inserting step includes inserting a redirecting device in the path of web traffic from the user through an aggregation router (column 2, lines 40-52; column 7, lines 1-20).

As per claim 46, Bakshi teaches the method of claim 1, wherein the inserting step includes inserting a redirecting device in the path of web traffic between a Network Address Translator (NAT) and an ISP (column 8, lines 24-32).

As per claim 47, Bakshi teaches the method of claim 46, wherein the NAT is connected to a Wi-Fi network (column 8, lines 24-32).

As per claim 48, Bakshi teaches the method of claim 47, wherein the Wi-Fi is adapted for accommodating a plurality of users (column 8, lines 24-32).

As per claim 49, Bakshi teaches the method of claim 48, wherein the redirecting device is further configured to identify each of the plurality of users on the Wi-Fi network (column 8, lines 24-32).

As per claim 50, Bakshi teaches the method of claim 49, wherein the redirecting device identifies each of the plurality of users by performing the following steps: a. temporarily redirecting the each active user to a visible or non-visible, null-Web page that sets a cookie with the required information to identify the action and user in the future; b. capturing the identity and previous activity flagged by the set cookie (column 7, lines 21-47).

As per claim 51, Bakshi teaches the method of claim 50, further including the step of sending a selected message to a selected one of the identified users (column 7, lines 21-47).

As per claim 52, Bakshi teaches the method of claim 46, wherein the redirecting device identifies each of the plurality of users by performing the following steps: a. temporarily redirecting the each active user to a visible or non-visible, null-Web page that sets a cookie with the required information to identify the action and user in the future; b. capturing the identity and previous activity flagged by the set cookie (column 7, lines 21-47).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bakshi et al. US Patent No. 6,772,200 in view of Eldering US Patent No. 6,615,039. Eldering teaches the invention as claimed including communicating between a server and clients (see abstract).

As per claim 45, Bakshi teaches the method of claim 1. Bakshi does not teach wherein the inserting step includes inserting a redirecting device in the path of web traffic from the user through a CMTS. Eldering teaches wherein the inserting step

includes inserting a redirecting device in the path of web traffic from the user through a CMTS. See column 19, line 35-56; column 19, line 7-26.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the inserting step of Bakshi with CMTS of Eldering. A person of ordinary skill in the art would have been motivated to do this to relay ad streams to clients.

Response to Arguments

12. Applicant's arguments filed April 2, 2008 have been fully considered but they are not persuasive.

The applicant argues that Bakshi's proxy handles two-way traffic on page 12 of the Remarks. The examiner agrees. Although Bashi's proxy handles two-way traffic, it still handles upstream traffic. The claim does not say that the proxy cannot handle two way traffic.

Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (The invention was directed to an epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have "relatively acceptable dimensional stability" and "some degree of flexibility," but are inferior to circuit boards impregnated with polyester-imide resins. The court upheld the rejection concluding that applicant's argument that the reference teaches away from using epoxy was insufficient to overcome the rejection since "Gurley asserted no discovery beyond what was known in the art." 27 F.3d at 554, 31 USPQ2d at 1132.).

Furthermore, "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391

F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See MPEP 2123 [R-5].

Moreover, the applicant argues that Bakshi's proxy is capable of changing content prior to returning it. Again, it is capable of changing it, but it is not necessary to change it in order for the invention to work. The applicant is again directed to the above section of the MPEP.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAHERA HALIM whose telephone number is (571)272-4003. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sahera Halim
Patent Examiner

July 5, 2008

/Ario Etienne/
Supervisory Patent Examiner, Art Unit 2157

Application Number**Application/Control No.**

10/623,893

**Applicant(s)/Patent under
Reexamination**

DONZIS ET AL.

Examiner

SAHERA HALIM

Art Unit

2157